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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,665	07/09/2003	Shiying Zheng	KPG-5081US	9324

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RATNERPRESTIA
P.O. BOX 1596
WILMINGTON, DE 19899

EXAMINER

GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,665

Applicant(s)

ZHENG ET AL.

Examiner

Barbara L. Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/2/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims

1. Claims 1-35 are present.
2. Claims 2-3, 15-17 are "product-by-process" claims. Applicant is reminded of MPEP 2113: "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 7-8, 10-11, 16-17, 26-27, 30 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a. Claims 7-8, 10-11, 16-17, 26-27 and 30-31 recite the limitation "dihydroxy compound" in claim 6, 9, 15, 25 and 29 respectively. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-35 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yanaka et al. (EP 1 203 660 A1).

a. The lithographic printing plate precursor of Yanaka et al. anticipates the presently claimed imageable element. Specifically, the precursor of Yanaka et al. comprises a hydrophilic support and an image-forming layer containing a heat radical-generating agent, a polymethine dye and at least one component selected from fine particles containing a compound having a radical polymerizable group and microcapsules encapsulating a compound having a radical polymerizable group (abstract). Yanaka et al. clearly teach that a urethane-based addition polymerizable compound produced using an addition reaction of isocyanate and a hydroxyl group is suitable as the compound having a radical polymerizable group ([0022], [0023], [0026], [0036], [0037]). This urethane-based addition polymerizable compound meets the present limitations for the polyurethane polymer. The polymethine dye, an infrared absorber, meets the present limitations for the photothermal conversion material ([0047]-[0061]). The image-forming layer contains a hydrophilic resin [0062] which meets the present limitations for the water soluble polymer. The image-forming layer can also contain a surface active agent preferably in an amount from 0.01 to 1 % by

weight ([0071]). After imagewise recording by heat, the precursor can be subjected to on-machine development by supplying a fountain solution and/or ink ([0092]-[0097]).

7. Claims 1-20, 23-35 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yanaka et al. (JP 2002-002135).

a. The original film for lithographic printing taught by Yanaka et al. clearly anticipates the present imageable element. Specifically the film has a heat-sensitive layer containing microcapsules containing a hydrophobic resin on substrate having a hydrophilic surface (abstract), wherein the hydrophobic resin can be a polyurethane resin ([0013]). The microcapsules have a mean diameter of 0.01 – 20 micrometers and are preferably used in an amount of ten to 50% by weight of the heat-sensitive layer ([0017]-[0018]). The polyurethane microcapsules meet the present limitations for the polyurethane particles. A hydrophilic resin can be added to the heat-sensitive layer ([0022]). This hydrophilic resin meets the present limitations for the water soluble polymer. The light-heat conversion agent is added to the heat-sensitive layer in an amount of 5 – 25 weight % ([0036]). A surfactant can be added to the heat-sensitive layer in the amount of 0.05 – 0.5 weight % ([0048]). After imagewise recording by heat, the precursor can be subjected to on-machine development using ink and dampening water ([0063]). MPEP 2113.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- a. In US 2002/0142244 A1, Takashima et al. teach a photopolymerizable composition and recording material (abstract).
- b. In US 6,794,104 B2, Tashiro teach a lithographic printing plate precursor comprising a fine particulate hydrophobicizing precursor (abstract).
- c. In US 6,653,050 B2, Fujimaki et al. teach an image-recording material for heat-mode exposure which comprises a polyurethane resin a photothermal converting agent and a compound capable of generating a radical through heat-mode exposure (abstract). There is no teaching or suggestion in Fujimaki et al. of polyurethane particles.
- d. In US 6,479,203 B1, Tashiro et al. teach a direct drawing type lithographic printing plate precursor (abstract).
- e. In US 6,171,748 B1, Tanaka et al. teach a lithographic plate for direct thermal lithography (abstract).
- d.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.
 - a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Barbara L. Gilliam

Barbara L. Gilliam
Primary Examiner
Art Unit 1752

bg

September 30, 2004